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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,357	06/02/2006	Raymond Campagnolo	291448US6X PCT	4580

22850 7590 11/27/2009

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EXAMINER	
MELLON, DAVID C	
ART UNIT	PAPER NUMBER
1797	

NOTIFICATION DATE	DELIVERY MODE
11/27/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/581,357	CAMPAGNOLO ET AL.	
	Examiner	Art Unit	
	DAVID C. MELLON	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/19/2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-72* is/are pending in the application.

4a) Of the above claim(s) *46-48,50,52 and 55-72* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-45,49,51,53 and 54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20060830; 20090630*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I and Species A1 and B1 (Claims 37-45, 49, 51, and 53-54 in the reply filed on 8/19/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 46-48, 50, 52, and 55-72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/19/2009.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37-38, 49, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedlaender et al. (USP 4,526,681).

Regarding claim 37, Friedlaender discloses a method of magnetically separating particles having different magnetic field susceptibilities (abstract) comprising:

- Sedimentation of magnetic particles by a first magnetic mechanism (C4/L58-C5/L15) and
- Formation of a plurality of residues in the second receptacle (collection reservoirs 16, see formation in figure 1).

Regarding claim 38, Friedlaender further discloses transport of first residue post sedimentation to the second receptacle, each second receptacle connected by a fluid channel (see in figure 1, channels feed to reservoirs 16, see also C5/L15-32).

Regarding claim 49, Friedlaender further discloses the first residue is moved as far as the second receptacles (see in figure 1, material residue only passes to 16).

Regarding claim 54, Friedlaender further discloses forming magnetic colloidal solution (C8/L65-C9/L20).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 37-45, 49, 51, and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colin et al. (USP 5,925,573).

Regarding claims 37-45, Colin et al. discloses a method for dividing an analyte present in solution in a first receptacle (8) into plural second receptacles (17), the analyte fixed on magnetic particles (C4/L1-55 - see discussion of particles with cores), the method (abstract) and in figures 2 and 3 comprising:

- Sedimentation of magnetic particles by a first magnetic mechanism (3, see also C2/L60-65, C8/L20-30, C10/L25-35)
- Formation of a plurality of residues in the second receptacles (C10/L15-30)
- The sedimentation first occurring in the first receptacle (C10/L15-30, see also figures, and also C8/L20-30)

- The first residue is transported by relative displacement of a magnetic field created by a second magnetic means (3 which is a long bar) which is coincident/the same with the first means (C8/L50-65, C2/L60-65)
- The fluid channels area parallel (see figure 3)
- The first residue is single and linear shaped (using magnet 3 it is inherently linear due to the linear magnet shape and would divide the receptacle into two parts)
- The fluid channels are all on the same side of the first residue (see figure 3)
- The magnet provides orthogonality of projection onto the plane of the displacement as required by claim 45
- The at least first residue is moved to the second receptacles (See figure 3, also see C10/L15-35)
- The channels are capillaries (C10/L45-65)
- The analyte is previously fixed and added to solution in the first receptacle (C4/L1-55).

While Colin et al. does not explicitly disclose all claim limitations within a single embodiment, it would have been obvious to one having ordinary skill in the art to combine the embodiments of figures 2 and 3 to change the magnet system of 3 into a moving bar magnet such as that of figure 2 and also at C2/L60-65 for the purpose of allowing for a maximization of transfer of magnetically susceptible particles due to the fact that the magnet itself is moving and thus a higher amount of material would be drawn than if a distant magnet source were used. Furthermore, it is established that

obviousness may be found in a combination of embodiments. See for example *Boston Scientific Scimed Inc. v. Cordis Corp* 89 USPQ2d 1704 in which two side by side stent embodiments were determined by the court to be combinable to render claims obvious.

Regarding claim 53, combined embodiment of figure 2/3 would result in a method of drawing the magnet to remove and transfer an equal amount to each second receptacle.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID C. MELLON whose telephone number is (571)270-7074. The examiner can normally be reached on Monday through Thursday 9:00am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tony G Soohoo/
Primary Examiner, Art Unit 1797

/D. C. M./
Examiner, Art Unit 1797